

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

NANO-SECOND TECHNOLOGY CO., )	CV 10-9176 RSWL (MANx)
LTD., a Taiwanese )	
Corporation, )	
	<b>ORDER Re: Defendants'</b>
Plaintiff, )	<b>Motion for Partial</b>
	<b>Summary Judgment of</b>
	<b>Invalidity [230]</b>
v. )	
DYNAFLEX INTERNATIONAL, )	
a California Corporation., )	
and GFORCE Corp. d/b/a DFX )	
SPORTS & FITNESS, a Nevada )	
Corporation, )	
Defendants. )	

Currently before the Court is Defendants Dynaflex International and GForce Corporation's ("Defendants") Motion for Partial Summary Judgment of Invalidity [230]. The Court having reviewed all papers submitted pertaining to this Motion and having considered all arguments presented to the Court, **NOW FINDS AND RULES AS FOLLOWS:**

The Court hereby **GRANTS** Defendants' Motion for Partial Summary Judgment.

1 **I. BACKGROUND**

2 Plaintiff Nano-Second Technology Co. ("Plaintiff")  
3 brought this Action against Defendant Dynaflex  
4 International and Defendant GForce Corporation d/b/a  
5 DFX Sports & Fitness ("Defendants") alleging  
6 infringement of Plaintiff's patent, United States  
7 Patent No. 5,800,311 ("`311 Patent").

8 The patent-in-suit involves a gyroscopic wrist  
9 exerciser containing light emitting diodes, a counter,  
10 and a string used to impart rotation on the rotor. See  
11 ECF No. 230-1, Schwartz Decl., Ex. 1. (the `311  
12 Patent).

13 Specifically, the wrist exerciser (10) claimed in  
14 the `311 patent includes a spherical rotor (40) mounted  
15 on a ring (30) within a hollow spherical casing  
16 (60), (11). The exerciser comes with a flexible rope  
17 (56) with a rigid end (55) that is inserted into a  
18 driving hole (45) formed in the groove (42) of the  
19 rotor (40). The rope (56) sits on the groove (42) and  
20 wraps around the rotor (40). The user can hold the  
21 exerciser (10) in one hand, while pulling the rope (56)  
22 with the other, to impart rotation to the rotor (40).  
23 Once the rotor (40) is given an initial spin, the user  
24 can gyrate the exerciser manually to cause the rotor to  
25 precess about an axis perpendicular to its spin axis.

26 The wrist exerciser (10) is also equipped with  
27 lighting elements (43) in the form of light emitting  
28 diodes (LEDs) arranged in the groove (42) of the rotor

1 (40). The LEDs are energized by coils (53) that are  
2 mounted on the rotor (40) and a magnet (34) that is  
3 mounted on the ring (30). The coils rotate within the  
4 magnetic lines of force of the magnet, which induces an  
5 electric current within the coils, and provide  
6 electricity to the LEDs. Finally, the wrist exerciser  
7 contains a counter (20) that displays the number of  
8 rotations of the rotor.

9 Plaintiff has asserted claims 1-5, 7, 9-12, 15, and  
10 17 ("asserted claims") of the '311 Patent in this  
11 Action. Defendant moves for partial summary judgment  
12 of invalidity on each of these claims. Claims 1 and 15  
13 are independent claims.

14 Claim 1 recites the following:

15 A wrist exerciser comprising a spherical casing  
16 having a first axis and a second axis  
17 substantially perpendicular to each other, a  
18 ring received within the spherical casing to be  
19 concentric with and rotatable about the first  
20 axis with respect to the casing and a spherical  
21 rotor received within the ring and having a  
22 rotational axis co-linear with the second axis  
23 to be rotatable about the second axis with  
24 respect to both the casing and the ring, the  
25 rotor having an outer surface on which a  
26 circumferential groove is formed with a driving  
27 hole formed in the groove, a flexible rope  
28 having a rigid end receivable in and engageable

1 with the driving hole. The flexible rope being  
2 windable around the outer surface of the rotor  
3 along the groove through a top opening formed  
4 on the casing so that the rotor is driven to  
5 rotate about the second axis by pulling to  
6 unwind the rope from the rotor, light  
7 generation means mounted on the rotor to emit  
8 light during the rotation of the rotor.

9 Claims 2, 5, and 9 depend on Claim 1. Claim 2  
10 discloses the additional limitation of "electrically  
11 driving lighting elements disposed in the groove" and  
12 an "electrical generator means." Claim 5 discloses the  
13 additional limitation of a "counter". Claim 9  
14 discloses the further limitation of partition plates  
15 that generate sound during rotation of the rotor.  
16 Claim 7 depends on Claim 5, and discloses a counter  
17 attached to the bottom opening of the casing, with a  
18 proximity detector actuateable by a magnet fixed in the  
19 groove of the rotor.

20 Claim 15 is identical to Claim 1 except that Claim  
21 15 recites "a counter being provided to count the  
22 rotations of the rotor about the second axis" instead  
23 of "light generation means." Claim 17 depends upon  
24 Claim 15, and discloses the additional limitation of a  
25 counter having a proximity detector actuateable by a  
26 magnet fixed in the groove of the rotor.

27 Previously, the Court construed the following  
28 claim terms: "driving hole"; "light generation means";

1 and "electrical generator means" [97].

2 The Court construed "light generation means" as a  
3 means-plus-function claim. The claimed function is "to  
4 generate light and emit light during rotation of the  
5 rotor". The Court found that the following structure  
6 corresponds to this function:

7 A ring magnet fixed to the ring and coaxial  
8 with the second axis and two coils fixed to the  
9 rotor and corresponding to the ring magnet for  
10 generating electrical current to power the  
11 light-emitting diodes [LEDs], which are  
12 disposed in the groove of the rotor and  
13 electrically connected to the coils.

14 The Court construed "electrical generator means" as  
15 a means-plus-function limitation. The claimed function  
16 is "supplying electrical current to the lighting  
17 elements." The Court construed the corresponding  
18 structure as "coils that cut through the magnetic line  
19 of force provided by the ring magnet; and a ring magnet  
20 fixed to the ring and coaxial with the second axis and  
21 two coils fixed to the rotor and corresponding to the  
22 ring magnet for generating electrical current to power  
23 the LEDs."

24 In its Motion, Defendants assert that at least five  
25 pieces of prior art render the '311 Patent obvious:  
26 U.S. Patent No. 5,353,655 ("the '655 Patent"); U.S.  
27 Patent No. 3,726,146 ("the Mishler '146 Patent"); U.S.  
28 Patent No. 3,945,146 ("the Brown '146 Patent"); U.S.

1 Patent No. 4,150,580 ("the '580 Patent"); and U.S.  
2 Patent No. D365,612 ("the '612 Patent").

3 **II. LEGAL STANDARD**

4 **A. Summary Judgment**

5 Summary judgment is appropriate when there is no  
6 genuine issue of material fact and the moving party is  
7 entitled to judgment as a matter of law. Fed. R. Civ.  
8 P. 56. A genuine issue is one in which the evidence is  
9 such that a reasonable fact-finder could return a  
10 verdict for the non-moving party. Anderson v. Liberty  
11 Lobby, 477 U.S. 242, 248 (1986).

12 A party seeking summary judgment always bears the  
13 initial burden of establishing the absence of a genuine  
14 issue of material fact. Celotex Corp. v. Catrett, 477  
15 U.S. 317, 322 (1986). "Where the moving party will  
16 have the burden of proof on an issue at trial, the  
17 movant must affirmatively demonstrate that no  
18 reasonable trier of fact could find other than for the  
19 moving party." Soremekun v. Thrifty Payless, Inc., 509  
20 F.3d 978, 984 (2007).

21 Once the moving party makes this showing, the  
22 non-moving party must set forth facts showing that a  
23 genuine issue of disputed material fact remains.  
24 Celotex, 477 U.S. at 322. The non-moving party is  
25 required by Federal Rule of Civil Procedure 56(e)<sup>1</sup> to go  
26

---

27 <sup>1</sup> The Federal Rules of Civil Procedure were amended on  
28 December 1, 2010. Federal Rule of Civil Procedure 56(e) has now  
been codified as Federal Rule of Civil Procedure 56(c).

1 beyond the pleadings and designate specific facts  
2 showing a genuine issue for trial exists. Id. at 324.

3 **B. Obviousness**

4 A party seeking to establish that patent claims are  
5 invalid must overcome the statutory presumption of  
6 validity set forth in 35 U.S.C. § 282 by clear and  
7 convincing evidence. Impax Labs., Inc. v. Aventis  
8 Pharms., Inc., 545 F.3d 1312, 1314 (Fed. Cir. 2008).

9 A patent is invalid for obviousness under 35 U.S.C.  
10 § 103 "if the differences between the subject matter  
11 sought to be patented and the prior art are such that  
12 the subject matter as a whole would have been obvious  
13 at the time the invention was made to a person having  
14 ordinary skill in the art." Takeda Chem. Indus. v.  
15 Alphapharm Pty., Ltd., 492 F.3d 1350, 1355 (Fed. Cir.  
16 2007).

17 Obviousness analysis is "objective":

18 Under § 103, the scope and content of the prior art  
19 are to be determined; differences between the prior  
20 art and the claims at issue are to be ascertained;  
21 and the level of ordinary skill in the pertinent  
22 art resolved. Against this background the  
23 obviousness or nonobviousness of the subject matter  
24 is determined. Such secondary considerations as  
25 commercial success, long felt but unsolved needs,  
26 failure of others, etc., might be utilized to give  
27 light to the circumstances surrounding the origin  
28 of the subject matter sought to be patented.

1 KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406  
2 (2007) (quoting Graham v. John Deere Co. of Kansas  
3 City, 383 U.S. 1 (1966), and stating that the Graham  
4 factors still control).

5 "[A] patent composed of several elements is not  
6 proved obvious merely by demonstrating that each of its  
7 elements was, independently, known in the prior art.  
8 Although common sense directs one to look with care at  
9 a patent application that claims as innovation the  
10 combination of two known devices according to their  
11 established functions, it can be important to identify  
12 a reason that would have prompted a person of ordinary  
13 skill in the relevant field to combine the elements in  
14 the way the claimed new invention does." Id. at 418.

15 In other words, obviousness depends on "whether the  
16 improvement is *more than the predictable use* of prior  
17 art," and whether there were *reasons* (e.g. demand,  
18 need, or problem known in the field or market) to  
19 combine the known elements or make such improvements in  
20 the fashion claimed by the patent at issue. Id. at  
21 417-18 (emphasis added).

22 The "combination of familiar elements according to  
23 known methods" is likely to be obvious when it "does no  
24 more than yield predictable results." Id. at 416. If  
25 an ordinarily skilled artisan can implement a  
26 predictable variation of a work available in the same  
27 field of endeavor or a different one, section 103  
28 likely bars patentability of the variation. Id.



1           "Whether an invention would have been obvious under  
2 35 U.S.C. § 103 is a question of law . . . based upon  
3 underlying factual questions." Takeda Chem., 492 F.3d  
4 at 1355. Summary judgment may be appropriate if "the  
5 content of the prior art, the scope of the patent  
6 claim, and the level of ordinary skill in the art are  
7 not in material dispute, and the obviousness of the  
8 claim is apparent in light of these factors." KSR  
9 Int'l Co., 550 U.S. at 427 (citing Graham, 383 U.S. at  
10 17).

### 11                                   **III. EVIDENTIARY OBJECTIONS**

12           As part of its Reply, Defendants filed an Ex Parte  
13 Application to strike portions of the declaration of  
14 Tony M. Lu, Plaintiff's counsel, filed with Plaintiff's  
15 Opposition [264]. The Court construed the Ex Parte  
16 Application as part of the Reply because the Ex Parte  
17 Application contains evidentiary objections that are  
18 ordinarily filed as part of the Reply. Plaintiff did  
19 not file a response.

20           The Court **SUSTAINS** Defendants' evidentiary  
21 objections to Paragraphs 5 through 8, and 10 through 14  
22 because they offer improper legal conclusions or expert  
23 testimony.

### 24                                   **IV. ANALYSIS**

#### 25           **A. Ordinary Skill in the Art**

26           The obviousness analysis requires determining the  
27 level of ordinary skill in the pertinent art. See  
28 Graham, 383 U.S. at 17-18. "Ascertaining the level of

1 ordinary skill in the art is necessary for maintaining  
2 objectivity in the obviousness inquiry." See Ryko Mfg.  
3 Co. v. Nu-Star, Inc., 950 F.2d 714, 719 (Fed. Cir.  
4 1991). Factors to consider include the educational  
5 level of the inventor, the educational level of those  
6 who work in the relevant industry, and the  
7 sophistication of the technology involved. See id.

8 Defendants contend that the level of ordinary skill  
9 in the art is as follows: a person having two or more  
10 years of post-secondary education in mechanical design  
11 and one or two years of experience designing toys,  
12 fitness devices or other electromechanical objects.  
13 Alternatively, one of ordinary skills could have been a  
14 high school graduate with aptitude for mechanical  
15 devices and two or more years designing toys, fitness  
16 devices, or other electromechanical objects. Schwartz  
17 Reply Decl. Ex. 1, Expert Report of Dr. Vijay Gupta on  
18 Defendants' Contention that the Asserted Claims of U.S.  
19 Patent No. 5,800,311 Are Invalid ("Gupta Report"), ¶  
20 49.

21 On the other hand, Plaintiff contends that a person  
22 of ordinary skill in the art would have a good  
23 understanding of the theory and practice of electronics  
24 hardware and mechanical design. A person of ordinary  
25 skill would thus have a Bachelor's degree or equivalent  
26 in Electrical Engineering, Mechanical Engineering, or  
27 Electronics and a year of relevant experience. Lu  
28 Decl., Ex. 1, Expert Report of Dr. Chi On Chui ("Chui

1 Report"), ¶ 34.

2 The Court finds that the slight differences  
3 identified by the Parties are not material to this  
4 Motion. Although Plaintiff appears to dispute the  
5 level of ordinary skill in the art, citing a slightly  
6 higher level, Plaintiff has not demonstrated how this  
7 is relevant to any of its analysis. For the purposes  
8 of this Motion, the Court assumes that a person of  
9 ordinary skill in the art possesses the qualities  
10 identified by Plaintiff: one of ordinary skill in the  
11 art would have a good understanding of electronics  
12 hardware and mechanical design. Such person will have  
13 a Bachelor's degree from a four-year college in  
14 Electrical Engineering, Electronics, and Mechanical  
15 Engineering, and a year of relevant experience.

16 **B. Scope and Content of the Prior Art**

17 Under the Graham test for obviousness, the Court  
18 must also determine the scope and content of the prior  
19 art. The scope of prior art is only that art which is  
20 analogous. See In re Clay, 966 F.2d 656, 658-59 (Fed.  
21 Cir. 1992). Analogous art is art that is not "too  
22 remote to be treated as prior art." In re Clay, 966  
23 F.2d at 657. In addition, a prior art reference is  
24 analogous if it is from the same "'field of endeavor,'  
25 even if it addresses a different problem, or, if not  
26 within the same field, if the reference is 'reasonably  
27 pertinent' to the particular problem with which the  
28 inventor is involved." In re Conte, 36 Fed. Appx. 446,

1 450, 2002 WL 1216965, \*4 (Fed. Cir. 2002) (citing In re  
2 Clay, 966 F.2d at 658-59). The determination of  
3 relevant prior art is a question of fact. In re Clay,  
4 966 F.2d at 658.

5 Relevant prior art is further defined by 35 U.S.C.  
6 §§ 102(a) and (b), which limit the time frame within  
7 which prior art can be found. Sections 102(a) and (b)  
8 provide:

9 A person shall be entitled to a patent unless --  
10 (a) the invention was known or used by others in  
11 this country, or patented or described in a printed  
12 publication in this or a foreign country, before  
13 the invention thereof by the applicant for patent,  
14 or  
15 (b) the invention was patented or described in a  
16 printed publication in this or a foreign country or  
17 in public use or on sale in this country, more than  
18 one year prior to the date of the application for  
19 patent in the United States.

20 Defendants contend that the asserted claims of the '311  
21 patent are invalid because they are obvious in view of  
22 prior art. Defendants point to five prior art patents  
23 in doing so:

24 **1. U.S. Patent No. 5,353,655 ("the '655 Patent"):**

25 The '655 Patent issued on October 11, 1994. The  
26 '655 Patent discloses a gyroscopic wrist exerciser with  
27 a spherical housing (10) and a rotor (12) within the  
28 housing. The rotor is mounted on a shaft (14) that

1 provides the spin axis (or the first axis) (36) for the  
2 rotor. The shaft ends (28) fit in notches (26) in a  
3 circular guide ring (24). The circular guide ring (24)  
4 sits in a circumferentially-extending groove (22) in  
5 the housing. The guide ring (24) rotates about the  
6 groove (22) around a second axis perpendicular to the  
7 ring. A user can initiate the rotation of the rotor by  
8 engaging the open end (16) of the casing or by running  
9 the device along a surface. The user can also manually  
10 gyrate the wrist exerciser, about a third axis  
11 perpendicular to the first and second axes, causing the  
12 rotor to precess about the second axes. This generates  
13 a torque about the third axis.

14 The wrist exerciser also includes coils (42) and  
15 permanent magnets (41) that use the rotation of the  
16 rotor to "generate electricity for operating various  
17 electrical visual or audio devices". These devices can  
18 include lights or counters. In one embodiment of the  
19 patent, the coil (42) is embedded in the housing (10),  
20 and the magnets (41) are mounted in the "outer  
21 periphery of the rotor". In another embodiment, the  
22 magnets are embedded in the housing and the coil is  
23 mounted on the rotor. The coils form a circuit with  
24 brushes and plate-like members, providing electricity  
25 to the audio or visual devices. See Schwartz Decl. Ex.  
26 2.

27  
28 ///

1           **2. U.S. Patent No. 3,726,146 ("the Mishler '146**  
2 **Patent"):**

3           The Mishler '146 Patent issued on April 10, 1973.  
4 The patent discloses a hand-held gyroscopic device  
5 comprising of a rotor (12) mounted within a cylinder  
6 (10) for rotation about perpendicular axes. The rotor  
7 includes a shaft (14) having a hole (34). The hole  
8 (34) receives a string that can be wrapped around the  
9 shaft (14). The user can impart rotation on the rotor  
10 by pulling on the string, and can manually gyrate the  
11 spinning rotor to cause the rotor to precess,  
12 generating a torque felt by the user. Id. Ex. 4.

13           **3. U.S. Patent No. 3,945,146 ("the Brown '146**  
14 **Patent"):**

15           The Brown '146 Patent issued on March 23, 1976. It  
16 discloses a gyroscope with a casing (11) housing a  
17 rotor (42), a shaft (26) and a starter element (39).  
18 A starter cord (22) is wound around a hub (50) of the  
19 starter element (39). Pulling the cord imparts  
20 rotation to the starter element. Id. Ex. 5.

21           **4. U.S. Patent No. 4,150,580 ("the '580 Patent"):**

22           The '580 Patent issued on April 24, 1979, and  
23 discloses a gyroscopic exerciser consisting of a  
24 spherical shell (10) and a rotor (18) mounted within  
25 the shell. The rotor has partition plates (90-96) that  
26 divide the central bore of the rotor into quadrants.  
27 The plates pull air into the shell during high  
28 rotational activity, cooling the exerciser. Id. Ex. 6.

1           **5. U.S. Patent No. D365,612 ("the '612 Patent"):**

2           The '612 Patent issued on December 26, 1995, which  
3 is a design patent for a gyroscopic exerciser. The  
4 patent depicts a rotor mounted for rotation within a  
5 spherical housing. Id. Ex. 7.

6           Defendants also contend that gyroscopic devices  
7 have appeared in advertisements since 1991. A number  
8 of these devices use string wound within a  
9 circumferential groove in the rotor to impart rotation  
10 on the rotor. Schwartz Decl. Ex. 8.

11           The Court finds that the prior art cited above are  
12 analogous prior art and sufficient to establish  
13 obviousness by clear and convincing evidence. Each of  
14 the prior arts are in the same field of endeavor as the  
15 '311 Patent, because they all relate to gyroscopic  
16 exercisers or gyroscopes. Plaintiff does not dispute  
17 the use of Defendants' cited prior art.

18           Further, the cited prior art also conforms to the  
19 time requirements of 35 U.S.C. §§ 102(a) and (b),  
20 because they were printed or patented before the filing  
21 of the '311 Patent, which is December 3, 1997.  
22 Schwartz Decl. Ex. 1. The Court notes that none of  
23 these references were considered by the U.S. Patent and  
24 Trademark Office (USPTO) during the initial examination  
25 of the '311 Patent.

26 **C. The Differences Between the Prior Art and Claimed**  
27 **Invention**

28           The final element in the Graham analyses requires

1 the determination of any differences between the  
2 teachings found in the prior art and the claimed  
3 invention, from the vantage point of a hypothetical  
4 person with ordinary skill in the art. See Graham, 383  
5 U.S. at 17-18; Velander v. Garner, 348 F.3d 1359, 1380  
6 (Fed. Cir. 2003). The claims of the patent-in-suit  
7 must be considered "as a whole." W.L. Gore & Assoc.,  
8 Inc. v. Garlock, Inc., 721 F.2d 1540, 1547-48 (Fed.  
9 Cir. 1983). It is "[t]he claims, not [the] particular  
10 embodiments [that] must be the focus of the obvious  
11 inquiry." Jackson Jordan, Inc. v. Plasser Am. Corp.,  
12 747 F.2d 1567, 1578 (Fed. Cir. 1984). Although it is  
13 entirely proper to use the specification of the patent  
14 to interpret what the patentee meant by a word or  
15 phrase in a claim, adding to the claim an extraneous  
16 limitation appearing in the specification is improper.  
17 See E.I. du Pont de Nemours & Co. v. Phillips Petroleum  
18 Co., 849 F.2d 1430, 1433 (Fed. Cir. 1988) (citations  
19 omitted).

20 On balance, the Court finds that there is little  
21 difference in the teachings of the prior art and the  
22 independent claims of the '311 Patent.

23 As to Claim 1, as argued by Defendants, the '655  
24 Patent teaches a spherical casing and a rotor received  
25 in a ring, which rotates about an axis perpendicular to  
26 the ring. The ring sits within the housing.

27 The '655 Patent also teaches the use of magnets and  
28 coils to generate electricity used to energize LEDs, as



1 claimed in the '311 Patent. Although the LEDs,  
2 magnets, and coils of the '655 Patent are not arranged  
3 in the same manner as in the '311 Patent, they perform  
4 the same function, and achieve the same result. As  
5 described by Defendants, in both the '311 Patent and  
6 the '655 Patent, the coils generate electricity by  
7 cutting through the magnet's lines of force. The  
8 location of the magnets, coils, and LEDs is merely a  
9 matter of design choice and does not change the overall  
10 operation of the exerciser. There are only a few  
11 places in the exerciser where one of ordinary skill  
12 could place a magnet, coils, and lighting elements.  
13 Gupta Report ¶¶ 88, 92 ("Details of the actual size,  
14 shape, type, and number of magnets and coils and their  
15 specific locations on the rotor and housing are  
16 essentially design choices and not new inventions.").  
17 A person of ordinary skill in the art would be expected  
18 to consider and effectuate mere design changes to the  
19 gyroscope involving the arrangement of magnets, coils,  
20 electrical circuits, and lights. Gupta Report ¶ 89  
21 ("Someone designing a gyroscopic wrist exerciser in  
22 1997, and wanting to add some form of electrical  
23 generator to run lights or other devices, could start  
24 with a structure equivalent to the electrical generator  
25 disclosed in the '655 Patent. It is a matter of choice  
26 for one of ordinary skill.").

27 Plaintiff has not identified how the specific  
28 location of the LEDs, magnets, and coils in the '311 is

1 distinguishable from the location of the magnets,  
2 coils, and LEDs in the '655 Patent, or somehow  
3 generates a novel or unexpected result. See  
4 Application of Kuhle, 526 F.2d 553, 555 (C.C.P.A. 1975)  
5 ("[T]he particular placement of the [battery] contact  
6 provides no novel or unexpected result. The manner in  
7 which electrical contact is made for Smith's battery  
8 would be an obvious matter of design choice within the  
9 skill of the art. . . . use of a spring-loaded contact  
10 in the manner claimed is well known with the common  
11 flashlight.") (citations omitted). Plaintiff cites to  
12 its expert's testimony that the location of the coils  
13 and magnets in the '311 Patent results in a more  
14 "efficient" means to generate electricity, but this  
15 opinion is conclusory and unsupported by any evidence.  
16 Thus the Court finds that it is insufficient to defeat  
17 summary judgment. Telemac Cellular Corp. v. Topp  
18 Telecom, Inc., 247 F.3d 1316 (Fed. Cir. 2001) ("broad  
19 conclusory statements offered by [Plaintiff's] experts  
20 are not evidence and are not sufficient to establish a  
21 genuine issue of material fact.").

22       The only limitation of Claim 1 that the '655 Patent  
23 does not teach is the use of a string to impart  
24 rotation on the rotor. The Mishler '146 and the Brown  
25 '146 both teach this missing limitation. Although  
26 neither discloses the use of a groove formed on the  
27 surface of the rotor to accommodate a string or a  
28 string with a rigid end, one of the ordinary skill

1 would have found it obvious to modify the rotor of the  
2 '655 Patent to contain a groove, and to make the string  
3 end rigid. A rigid end makes it easier to insert a  
4 string into a driving hole, and a groove in the rotor  
5 would enable the use of the string to impart rotation  
6 on the rotor. Gupta Report ¶ 111. These are merely  
7 design alternatives to solving the problem of how to  
8 impart rotation on the rotor. Id. ¶ 111. Further, the  
9 known prior art depicted in Figure 5 of the '311 Patent  
10 depicts the use of a groove on the rotor, a driving  
11 hole, and a flexible rope with a rigid end.

12 Next, the Court finds that there was an incentive  
13 to combine the teachings of the '655 Patent with the  
14 Mishler '146 and Brown '147 to provide an alternative  
15 means to impart rotation to the rotor of the '655  
16 Patent. The Mishler '146 Patent itself identifies the  
17 use of a string as an alternative to spinning the rotor  
18 by hand. Schwartz Decl., Ex. 4 (Mishler Patent), 3:29-  
19 40 ("It will be apparent that the rotor 12 of FIGS. 1  
20 and 2 can be given an initial spin by holding the  
21 support structure 10 of the device in one hand and  
22 rapidly moving the other hand in a direction  
23 perpendicular to the shaft 14 in a path which engages  
24 the palm of the hand with the rim of the rotor.  
25 Alternatively the shaft 14 may have a hole 34 extending  
26 diametrically through the shaft as shown in FIG. 2 and  
27 one end of a string may be inserted through such hole  
28 and the string wrapped around the shaft. Pulling the

1 string will then spin the rotor 12." ). The incentive  
2 to combine prior art references can come from the prior  
3 art itself or be reasonably inferred from the "nature  
4 of the problem to be solved, leading inventors to look  
5 to references related to solutions to that problem."  
6 Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75  
7 F.3d 1568, 1573 (Fed. Cir. 1996). Further, Defendants  
8 have provided evidence, which Plaintiff does not  
9 dispute, that the wrist exerciser industry sought to  
10 improve the attractiveness of ordinary gyroscopic  
11 exercisers to consumers by adding additional features,  
12 such as an alternative means to impart rotation on the  
13 gyroscope and fanciful lighting elements. See Gupta  
14 Decl. ¶¶ 104-105. A person of ordinary skill would be  
15 motivated to make improvements and add appealing  
16 features to a basic wrist exerciser to enhance its  
17 marketability. Id. ¶ 109-110.

18 Plaintiff's only other argument is that there is  
19 "no reasonable expectation of success" to combine the  
20 teachings of the '655 and Mishler and Brown '146  
21 Patents, but again this is conclusory. Further, this  
22 is not a requirement to finding obviousness. See KSR  
23 Int'l Co., 550 U.S. at 415 (holding that the  
24 obviousness analysis is flexible and expansive).

25 The Court finds the remaining independent claim,  
26 Claim 15, is identical to Claim 1 except that Claim 15  
27 recites "a counter being provided to count the  
28 rotations of the rotor about the second axis" instead

1 of "light generation means." The '655 Patent teaches  
2 the use of a counter. For the reasons discussed above  
3 in relation to Claim 1, the Court finds Claim 15  
4 obvious.

5 The Court finds the remaining dependent claims of  
6 the '311 Patent obvious, as follows.

7 Claim 2 of the '311 Patent is obvious over the '655  
8 Patent in view of the Mishler '146 or Brown '146  
9 Patents. The claimed function of Claim 2 is similar to  
10 that disclosed in the '655 Patent. In the '655 Patent,  
11 electricity is generated by coils and magnets that  
12 energize LEDs connected to the coils. Further, the  
13 claimed structure of Claim 2, involving the arrangement  
14 of magnets and coils on the rotor, is similar to the  
15 arrangement of magnets and coils disclosed in the '655  
16 Patent, as discussed above.

17 Claim 3 depends on Claim 2, and adds "wherein the  
18 generator means comprises at least one coil of  
19 conductive wire fixed on the rotor to be in electrical  
20 connection with the lighting elements and a magnet  
21 fixed to the ring and having magnetic line of force,  
22 the magnet being positioned corresponding to the coil  
23 so that the rotation of the rotor moves the coil to cut  
24 through the magnetic line of force of the magnet and  
25 thus induce an electrical current in the conductive  
26 wire of the coil which is supplied to light the  
27 lighting elements." The Court finds that for the same  
28 reasons as Claims 1 and 2, Claim 3 is obvious over the

1 '655 Patent in view of the Mishler '146 or Brown '146  
2 patents as applied to Claim 1. The magnets and coils  
3 of the '655 Patent generate an electrical current, as  
4 the coils "cut through the magnetic line of force of  
5 the magnet". The disposition of the coils and magnets  
6 is merely a design choice.

7 Claim 4 depends on Claim 3, and adds "wherein the  
8 generator means comprises two coils provided on two  
9 opposite sides of the rotational axis of the rotor."  
10 The Court finds that for the same reasons as Claims 1-  
11 3, Claim 4 is obvious over the '655 Patent in view of  
12 the Mishler '146 or Brown '146 patents as applied to  
13 Claim 1. Again, although Plaintiff argues that the  
14 '655 Patent discloses a different arrangement of coils  
15 and magnets than the '311 Patent, it has not explained  
16 how the structure disclosed in the '311 Patent is  
17 novel. As discussed above, the arrangement of the  
18 magnets and coils in the '655 Patent generates an  
19 electric current in the same way as the magnets and  
20 coils in the '311. How they are arranged is a matter  
21 of design choice.

22 Claim 5 depends on Claim 1, but adds a "counter."  
23 For the reasons discussed above for Claim 1, the Court  
24 finds that Claim 5 is obvious over the '655 Patent in  
25 view of the Mishler '146 and Brown '146 Patents as  
26 applied to Claim 1. Plaintiff acknowledges that the  
27 '655 Patent discloses a counter. The Court finds that  
28 there was a motivation to add a counter to a wrist

1 exerciser because it would have enhanced the  
2 attractiveness of the wrist exerciser to customers.  
3 Gupta Report ¶ 117.

4 Claim 7 depends on Claim 5, and adds "wherein the  
5 casing comprises a bottom opening and wherein the  
6 counter comprises a surface which is attached to the  
7 bottom opening of the casing, the surface having a  
8 proximity detector mounted thereon to be corresponding  
9 to and actuateable by a magnet fixed in the groove of  
10 rotor so as to obtain the rotation turns of the rotor,  
11 the counter comprising a display to show number of the  
12 rotation turns." The Court finds that Claim 7 is  
13 obvious over the '655 Patent in view of the Mishler  
14 '146 or Brown '146 Patent as applied to Claim 1. The  
15 '655 Patent discloses the use of a counter on a wrist  
16 exerciser for counting the number of rotations made by  
17 the rotor. Further, the Court finds that all counters  
18 require sensors, and that one of ordinary skill in the  
19 art would have been able to mount a sensor, such as a  
20 magnet, on the rotor to actuate the counter.

21 Although the '655 Patent does not disclose a  
22 particular *location for the counter*, the specific  
23 arrangement of the counter involves nothing more than a  
24 design choice. Gupta Report ¶ 120. Moreover, there  
25 are only so many places on the wrist exerciser where  
26 one can attach a counter. See KSR, 550 U.S. at 416  
27 (The "combination of familiar elements according to  
28 known methods" is likely to be obvious when it "does no

1 more than yield predictable results.”). A person of  
2 ordinary skill of the art would have found it obvious  
3 to mount a counter on the bottom of the '655 Patent.

4 The Court also finds that Claim 9 of the '311  
5 Patent is obvious over the '655 Patent in view of the  
6 Mishler '146 or Brown '146 Patent as applied to Claim  
7 1. The '580 and '612 Patents both teach the use of  
8 rotor fins that cause air to enter the interior of the  
9 shell. The '580 Patent identifies a reason for adding  
10 fins to a rotor: to “provide internal cooling of the  
11 entire device as the rotor turns.” Schwartz Decl. Ex.  
12 6, 1:46-49; see also Gupta Report ¶¶ 122-123. Sound is  
13 generated when air whips through the device. One of  
14 ordinary skill in the art would have found it obvious  
15 to modify the rotor of the '655 Patent to include fins  
16 and partitions to generate sound, as claimed in Claim  
17 9.

18 The Court finds that Claim 10 is similar to Claim  
19 9, except that Claim 10 includes an additional  
20 partition plate. Both the '580 and '612 Patents  
21 disclose the use of multiple partition plates. For the  
22 same reasons as discussed above, the Court finds that  
23 Claim 10 of the '311 Patent is obvious over the '655  
24 Patent in view of the Mishler '146 or Brown '146 Patent  
25 as applied to Claim 1. Plaintiff also does not dispute  
26 that the '580 Patent discloses the additional  
27 limitation of Claim 10.

28 Claim 11 depends on Claim 9, and recites “wherein



1 each of the chambers comprises a weight block fixed  
2 therein." For the same reasons as discussed above, the  
3 Court finds that Claim 11 of the '311 Patent is obvious  
4 over the '655 Patent in view of the Mishler '146 or  
5 Brown '146 Patent as applied to Claim 1, and further in  
6 view of the '580 Patent. A person with ordinary skill  
7 in the art, motivated to increase the rotational speed  
8 of the rotor, would have been able to modify the rotor  
9 of the '655 Patent to include a weight block, such as a  
10 metal ring disclosed in the '580 Patent.

11 Claim 12 depends on Claim 2, and adds "wherein the  
12 lighting elements comprise light emitting diodes." The  
13 '655 Patent discloses the use of LEDs. For the reasons  
14 discussed above in relation to Claim 2, the Court finds  
15 Claim 12 obvious.

16 Finally, Defendants point out that Claim 17 is  
17 identical to Claim 7, with exception that claim 7  
18 depends from Claim 5. Thus for the same reasons  
19 discussed for Claim 7, Claim 17 is obvious.

20 Accordingly, the prior art teaches the limitations  
21 in the asserted claims in this Action. The Court finds  
22 that Defendants have shown by clear and convincing  
23 evidence that the asserted claims are obvious.

24

25

26

27

28 ///

1 **V. CONCLUSION**

2 For the foregoing reasons, the Court **GRANTS**  
3 Defendants' Motion for Partial Summary Judgment of  
4 Invalidity.

5  
6 **IT IS SO ORDERED.**

7 DATED: May 10, 2013

8 RONALD S.W. LEW

9 

---

**HONORABLE RONALD S.W. LEW**  
Senior, U.S. District Court Judge

10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28